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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,852	06/27/2003	Keith M. Orr	104934-0002	8742
21125	7590	12/07/2005	EXAMINER	
NUTTER MCCLENNEN & FISH LLP WORLD TRADE CENTER WEST 155 SEAPORT BOULEVARD BOSTON, MA 02210-2604			BOTTORFF, CHRISTOPHER	
			ART UNIT	PAPER NUMBER
			3618	

DATE MAILED: 12/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/608,852	ORR ET AL.	
	Examiner	Art Unit	
	Christopher Bottorff	3618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 14 October 2005.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-9, 12-31, 33-39, 41 and 42 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-9, 12-31, 33-39, 41, and 42 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The amendment filed October 14, 2005 has been entered. Claims 32 and 40 are canceled. Claim 42 is added. Claims 1-9, 12-31, 33-39, 41, and 42 are pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-9, 12-31, 33-39, and 41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Independent claims 1, 13, 24, 29, 36, and 41 each require the connecting member (second member coupled to the first member, ball-and-socket interface) to allow movement along longitudinal and lateral axes while preventing rotational and translational movement. However, the disclosure does not establish the effects of any element on translational movement, particularly when the element must also effect other forms of movement. Since translational movement is not addressed in the disclosure in relation to a specific element, the disclosure fails to offer support for the claimed connecting member (second member coupled to the first member, ball-and-socket interface).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 29-31, 33-38, 41, and 42 are rejected under 35 U.S.C. 102(b) as being anticipated by Shands US 4,740,804.

Shands discloses a suspension system comprising a first member 128, a second member 104, a connecting element 106, 110, 114, and at least one compression element 150. See Figures 2 and 3. The first member 128 has an upper surface adapted to support a foot and an opposed lower surface. See Figure 3 and column 6, lines 35-40. The second member 104 is positioned a distance apart from the lower surface of the first member 128 and has upper and lower surfaces. See Figure 2. The connecting element 106, 110, 114 is positioned between the lower surface of the first member 128 and the upper surface of the second member 104. See Figure 2. The second member 104 is connected to the first member 128 through the connecting element, which is adapted to allow movement of the first member about longitudinal and lateral axes of the first member while preventing rotational and translational movement

of the first member with respect to the second member about a vertical axis central to the first and second members. See column 5, lines 11-27. The connecting element is in the form of a ball-and-socket interface disposed between the lower surface of the first member 128 and the upper surface of the second member 104. See Figure 2. Also, the at least one compression element 150 is positioned between the lower surface of the first member 128 and the upper surface of the second member 104 and is adapted to control movement between the first and second members. See Figure 2 and column 6, lines 49-59.

The at least one compression element 150 is adapted to compress between the first and second members upon movement of the first member, and the at least one compression element is removably disposed between the first and second members. See Figure 2.

In regard to claims 34 and 42, the arrangement of Shands may be viewed alternatively from that presented above such that Shands discloses a suspension system comprising a first member 114, a second member 110, and a connecting element 106. See Figures 2 and 3. The first member 114 has an upper surface adapted to support a foot, an opposed lower surface, and a central aperture therein with an inner, concave wall. See Figures 2 and 3 and column 6, lines 35-40. The second member 110 is positioned a distance apart from the lower surface of the first member 114 and has upper and lower surfaces. See Figures 2 and 3. The connecting element 106, which is in the form of a support ring, is positioned between the lower surface of

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the first member 114 and the upper surface of the second member 110. See Figure 2. The support ring 106 connects the first and second members and has a convex peripheral portion that interfaces with the inner, concave wall of the central aperture of the first member 114 such that the interface is effective to allow movement of the first member 114 with respect to the support ring 106. See Figure 2 and column 5, lines 56-60. The support ring 106 is also adapted to allow movement of the first member 114 about longitudinal and lateral axes of the first member 114 while preventing rotational and translational movement of the first member 14 with respect to the second member 110 about a vertical axis central to the first and second members. See column 5, lines 11-27.

Claims 13, 29-31, 33, 36, 38, and 39 are rejected under 35 U.S.C. 102(e) as being anticipated by Humbel US 6,428,032.

Humbel discloses a binding support and suspension system for mounting a rider's foot to a recreational riding device. The system comprises a first member in the form of base plate 15 (including the plate to which bolts 16 are attached and from which prongs 32 extend) having a first, lower, surface adjacent to and spaced apart from a surface of a recreational riding device and a second, upper, surface adapted to support the rider's foot. See Figure 2. At least one connecting element 7 is provided and is adapted to connect the base plate to the recreational riding device such that the base plate is capable of movement about longitudinal and lateral axes and of being prevented from rotational and translational movement about a vertical axis that is central to and

extends substantially perpendicular to the base. See Figure 1; column 3, lines 26-60; column 5, lines 55-59; and column 6, lines 24-41.

Humbel further discloses a recreational riding device comprising an elongate board member 3 having upper and lower surfaces. See Figure 1. The binding system further has a second member positioned a distance apart from the lower surface of the base plate and has upper and lower surfaces. The second member is in the form of a support that is mated to the elongate board member and defines a central vertical axis axially along screw 8. See column 3, lines 54-60. The connecting element 7 is positioned between the lower surface of the first member and the upper surface of the second member, mates the base plate to the support, and is adapted to allow movement about longitudinal and lateral axes and of being prevented from rotational and translational movement about a vertical axis that is central to and extends substantially perpendicular to the base. See Figure 1; column 3, lines 26-60; column 5, lines 55-59; and column 6, lines 24-41.

The connecting element 7 comprises a support ring 70 hingedly connected to the base plate to allow movement of the base plate. See Figures 1, 2, and 5 and column 3, lines 51-54. The support ring is adapted to mate to the support. See column 3, lines 54-60. At an interface between the support ring and the base plate, the base plate includes at least one slot, formed by forks 93, formed therein for receiving at least one pin member 71a formed on the support ring, the at least one slot and pin members being effective to prevent rotation between the base plate and the support ring in the horizontal plane. See Figures 2 and 5. Each of an inner surface of the support ring and

an outer surface of the support includes cooperating surface features formed thereon and are effective to prevent rotational movement of the support ring with respect to the support. See column 3, lines 54-60.

Two compression members 17 are disposed between the lower surface of the base plate and the upper surface of the support and are adapted to removably mate to the lower surface of the base plate. See Figures 2 and 5. The compression members are formed from an elastomeric polymer. See column 3, line 64. The compression members 17 are effective to compress between the base plate and the recreational riding device in response to a force applied to at least one of the base plate and the recreational riding device. See Figures 2 and 5 and note that compression of members 17 occurs at a location between the base plate and the recreational riding device. The compression members 17 are adapted to control movement of the base plate. The compression members 17 are each spaced substantially equidistant from one another and from a central axis of the base plate. See Figures 2 and 5.

The base plate includes at least one flexible attachment member 33 adapted to engaging a rider's foot, which flexible attachment member serves as a binding member. See Figure 2; column 4, lines 19-30; and column 7, lines 12-17. The base plate includes an engagement element 28 formed thereon for mating with a corresponding engagement element formed on a boot worn by the rider. See Figure 2 and column 7, lines 35-38. At least one locking member, in the form of a knurled surface, is adapted to prevent pivotal movement of the base plate in a particular direction about the central axis and the locking member is disposed between the base plate and the elongate

board member. See column 3, lines 54-60. Also, the base plate includes a central opening 14 adapted to surround the support. See Figure 2.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 9, 12, 14-17, 19, 20, and 22-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Humbel US 6,428,032 in view of Acuna, Jr. US 5,876,045.

Although Humbel discloses that the base plate mates to the support in the manner known generally (see column 3, lines 57-60), Humbel does not disclose that the manner known generally is to provide the support as a support base with a first end adapted to mount upon the recreational riding device and a second end adapted to be oriented adjacent the rider's foot with the fixed vertical central axis extending between the first and second ends of the support base. Humbel also does not disclose that the at least one slot is formed on the support ring and the at least one pin member is formed on the base plate, but that that the at least one slot is formed on the base plate and the at least one pin member is formed on the support ring. In addition, Humbel also does not disclose third and fourth compression members.

However, Acuna, Jr. teaches a manner of mating a base plate to a support that is known generally is to provide the support as a support base 15 with a first, lower, end

adapted to mount upon the recreational riding device and a second, upper, end adapted to be oriented adjacent the rider's foot with a fixed central axis, at shaft 40, extending between the first and second ends of the support base. See Figure 2. A knurled surface 28 of the support base 15 connects with a knurled surface 30 of the base plate 10. See column 3, lines 30-34. From the teachings of Acuna, Jr., providing the support of Humbel as a support base with a first end adapted to mount upon the recreational riding device and a second end adapted to be oriented adjacent the rider's foot such that the fixed central axis extending between the first and second ends of the support base would have been obvious to one of ordinary skill in the art at the time he invention was made. Providing this arrangement would be effective in allowing the base plate to be arranged in the desired angle and position relative to the recreational riding device while also allowing the base plate to be held in position.

In regard to the arrangement of the slot and pin, forming the slot on the support ring and the at least one pin member on the base plate, rather than the at least one slot on the base plate and the at least one pin member on the support ring as disclosed by Humbel, represents a reversal of part that would have been obvious to one of ordinary skill in the art at the time he invention was made. Such a modification would provide an effective pivotal connection between the base plate and support ring.

Claims 6-8 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Humbel US 6,428,032 in view of Acuna, Jr. US 5,876,045 as applied to claims 5 and 16 above, and further in view of Knapschafer Us 5,971,419.

Humbel also does not disclose third and fourth compression members. However, Knapschafer teaches the desirability of providing a binding system with four compression members 46 spaced substantially equidistant from one another and from a central axis. See Figures 3 and 4. From the teachings of Knapschafer, providing the system of Humbel with third and fourth compression members, in addition to the first and second compression members, such that the compression members are equidistant from one another and from a central axis of a base plate would have been obvious to one of ordinary skill in the art at the time he invention was made. This would provide greater support to the base plate.

Response to Arguments

Applicant's arguments with respect to the rejections in view of Metzger and Ware have been fully considered and are persuasive in light of the amendments to the claims. Therefore, the rejections have been withdrawn. However, upon further consideration, new grounds of rejection are made in view of Shands.

Applicant's arguments in view of Humbel have been fully considered but they are not persuasive.

Applicant asserts that Humbel does not prevent translation along the Z axis because adjustments may be made between fork 93 and protrusions 71a and 71b. This is discussed in column 5, lines 45-59. However, once the adjustments are made via screws 16, the components can be locked into position and translation can be prevented. See column 5, lines 55-59, and column 6, lines 24-41. Moreover, the claims

only require that connecting element 7. Thus, the claimed prevention of “translational movement,” although not supported by Applicant’s disclosure, is satisfied by Humble.

Also, claim 18 was previously indicated as having allowable subject matter, but the indication of the claim’s allowability has been withdrawn due to the rejection of claim 18 under 35 USC 112, first paragraph. Also, claim 42 does not include all of the limitation of claim 18, particularly all of the limitations of previously filed claims 13, 14, and 17, and does not distinguish over the prior art.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Bottorff whose telephone number is (571) 272-6692. The examiner can normally be reached on Mon.-Fri. 7:30 a.m. - 4:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Ellis can be reached on (571) 272-6914. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Christopher Bottorff



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